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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,282	09/24/2003	Iwata Ikeda	64484-013	3504
7590 McDermott, Will & Emery 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER DULANEY, BENJAMIN O	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 07/29/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,282

Applicant(s)

IKEDA ET AL.

Examiner

BENJAMIN O. DULANEY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 5/18/09 have been fully considered but they are not persuasive.

Regarding applicant's argument that Hansen does not teach "bringing processes required to construct the workflow and parameter values for the processes into correspondence with each attribute", examiner disagrees. The previously cited section of Hansen (Column 18, lines 51-53) details policies effecting the workflow of jobs, such as a policy that "can be implemented to force the whole document to print on a particular resource, ignoring the special attributes of those pages". In this example, the "processes required" would be the selection/printing of the particular resource, and the "parameter values" would include whatever standard values the special attributes would inherently have to be converted to for the job to be printed on the particular chosen resource. Therefore, using this simple interpretation of the claims, Hansen clearly teaches the newly added feature and the previous rejection stands.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent^[1] and recent Federal Circuit decisions^[2] indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to an apparatus or a machine or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Furthermore, the tie must be meaningful. A machine tied only to an intended use statement or to insignificant pre or post solution activity is not a meaningful tie. The tie must be in relation to a step or steps that are significant to the invention, or basic inventive concept. For example, the steps of claim 10 are not tied to a particular apparatus; hence a person could be controlling a computer to perform the steps of designating attributes, creating the workflow, etc. The tie must be claimed outside the preamble. Examiner suggests possibly tying one or more of the core steps to an apparatus component as seen in figure 2 of applicant's specification.

^[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

^[2] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1) Claims 1, 2, 4, 5, 8-11, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,509,974 by Hansen.
- 2) Regarding claims 1, 10 and 13, Hansen teaches an apparatus for generating a workflow for making image recording media recorded with images expressed by page data from the page data described in page description language, comprising: a designator for designating attributes of the image recording media constituting finally resulting matter resulting due to processing based on the workflow to be created (column 6, lines 20-60; figures 2 and 4; specifically lines 55-60 detailing attribute selection); and a workflow creator for creating the workflow by deciding upon processes required in order to make the image recording media and parameter values for the required processes based on attributes designated by the designator (column 11, line 64 - column 12, line 2; figures 2 and 4; the "tickets" which control the workflow operation can be interpreted as the workflow itself), wherein the workflow creator comprises: a rule storage unit for storing rules, bringing processes required to construct the workflow and parameter values for the processes into correspondence with each attribute

selectable for the image recording media, for creating the workflow for making the image recording media, in advance (column 18, lines 51-56; figures 2 and 4; in example cited in Hansen the processes would be the selection/printing of the particular resource, and the "parameter values" would include whatever standard values the special attributes would inherently have to be converted to for the job to be printed on the particular chosen resource); an environmental information storage unit for storing in advance environmental information indicating an environment for executing each process capable of being selected for making the image recording media (column 18, lines 46-51; a capability that is not available on the printers or a queue that is too big is "environment information" as defined by applicant's specification); and a process content decider for deciding upon processes required to make the image recording media and parameter values for the required processes based on attributes designated by the designator by referring to the rules and the environmental information (column 18, lines 49-51).

3) Regarding claims 2, 11 and 14, Hansen teaches the apparatus of claim 1, further comprising a ticket creator for creating a job ticket indicating content of processes required to make the image recording media based on the workflow created by the workflow creator (column 4, lines 46-51; figures 2 and 4).

4) Regarding claim 4, Hansen teaches the apparatus of claim 2, further comprising: a display having a prescribed screen (figure 4); a pointing device operated by a user for designating positions of the screen (column 8, lines 64-65); and a display controller for displaying a plurality of icons indicating the respective attributes selectable for the

image recording media constituting the finally resulting matter at the display (column 8, lines 59-62), wherein the designator registers an attribute indicated by a selected icon as an output requirement when one of the plurality of icons is selected due to an operation of the pointing device (column 12, lines 2-16); the workflow creator creates a workflow based on attributes registered as output requirements (column 11, line 64-column 12, line 2); and when the workflow creator creates a workflow, the display controller displays the created workflow at the display (figure 4; column 12, lines 56-62).

5) Regarding claim 5, Hansen teaches the apparatus of claim 4, wherein: the display controller displays a first area displaying a plurality of icons indicating the respective selectable attributes (figure 4, item 302), a second area displaying icons indicating attributes registered as output requirements (figure 4, item 306), and a third area displaying the created workflow in a distinguishable manner at the screen (figure 4, item 306); and when one of the icons displayed at the first area is dragged and dropped to the second area by the pointing device, the designator registers the attribute indicated by the dragged and dropped icon as an output requirement (column 16, lines 53-65).

6) Regarding claim 8, Hansen teaches a printing and prepressing manufacturing system comprising the apparatus of claim 1 and further comprising an executor for executing processing on the page data based on the workflow created by the workflow creator so as to make the image recording media with attributes designated by the designator (column 12, lines 31-46).

7) Regarding claim 9, Hansen teaches a printing and prepressing manufacturing system comprising the apparatus of claim 2 and further comprising: a ticket storage unit for storing tickets generated by the ticket creator (figure 2, item 204), and an executor for issuing tickets saved at the ticket storage unit when new page data is obtained and executing processing of the content indicated by the issued ticket on the new page data so that the image recording media having attributes designated by the designator is made (column 4, lines 46-51).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 8) Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,509,974 by Hansen.
- 9) Regarding claim 6, Hansen teaches the apparatus of claim 5, wherein: when one of the icons registered as an output requirement displayed in the second area is clicked using the pointing device, the display controller separately displays an operation screen for setting detailed content for the attribute indicated by the clicked icon at the display, and the designator registers detailed content set based on user operations of the separately displayed operation screen as output requirements (column 10, lines 23-38).

Hansen does not specifically teach double-clicking.

Examiner takes official notice that double-clicking is a well-known in the art means of selection on a display and it would be obvious to modify the clicking of Hansen with a double-click.

10) Regarding claim 7, Hansen teaches the apparatus of claim 4, wherein when one of the plurality of icons indicating the respective selectable attributes is clicked by the pointing device, the designator registers the attribute indicated by the clicked icon as output requirements (column 10, lines 23-38).

Hansen does not specifically teach double-clicking.

Examiner takes official notice that double-clicking is a well-known in the art means of selection on a display and it would be obvious to modify the clicking of Hansen with a double-click.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN O. DULANEY whose telephone number is (571)272-2874. The examiner can normally be reached on Monday - Friday (10am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin O Dulaney/

Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625